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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/208,140      12/09/98      DEL VECCHIO      A      P50743

020462      HM12/0228  
SMITHKLINE BEECHAM CORPORATION  
709 SWEDLAND ROAD P O BOX 1539  
KING OF PRUSSIA PA 19406-0939

EXAMINER

ZEMAN, R

ART UNIT

PAPER NUMBER

1645

DATE MAILED:

02/28/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/208,140

Applicant(s)

Del Vecchio

Examiner

Robert A. Zeman

Group Art Unit

1645



☒ Responsive to communication(s) filed on Dec 9, 1998.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-18 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-18 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

Claims 1-18 are pending.

#### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, drawn to polynucleotides, vectors and methods of making a recombinant protein using those vectors, classified in class 536, subclass 23.1.
- II. Claims 10 and 11, drawn to polypeptides, classified in class 530, subclass 350.
- III. Claim 12, drawn to antibodies, classified in class 530, subclass 388.1.
- IV. Claim 13, drawn to antagonists, classified in class 514, subclass 2.
- V. Claims 14 and 15, drawn to methods of identifying modulators, classified in class 435, subclass 5.
- VI. Claims 16 and 18, drawn to method of immunization using polypeptide, classified in class 424, subclass 189.1 .
- VII. Claim 17, drawn to method of immunization using polynucleotide vector, classified in class 424, subclass 225.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be

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made by another and materially different process (MPEP § 806.05(f)). In the instant case the polypeptides can be isolated from infected cells or made synthetically.

Inventions I and III are separate and distinct as they comprise completely differing biochemical and immunological entities having differing properties and uses. Invention I is drawn to polynucleotides, whereas Invention III is drawn to antibodies.

Inventions I and IV are separate and distinct as they comprise completely differing biochemical and immunological entities having differing properties and uses. Invention I is drawn to polynucleotides, whereas Invention IV is drawn to antagonists

Inventions I and V are separate and distinct as the polynucleotides of Invention I cannot be used in the methods of Invention V.

Inventions I and VI are separate and distinct as the polynucleotides of Invention I cannot be used in the methods of Invention VI.

Inventions I and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the polynucleotides can be used in other methods such as hybridization studies.

Inventions II and III are separate and distinct as they comprise completely differing biochemical and immunological entities having differing properties and uses. Invention II is

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drawn to polypeptides, whereas Invention III is drawn to antibodies with specificity to the polypeptides of Invention II.

Invention II and Invention IV are separate and distinct as they comprise completely differing biochemical and immunological entities having differing properties and uses. Invention II is drawn to polypeptides, whereas Invention IV is drawn to antagonists that affect the expression or activity of the polypeptides of Invention II.

Inventions II and V are separate and distinct as the polynucleotides of Invention II cannot be used in the methods of Invention V.

Inventions II and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the polypeptides can be used in other methods such as immunoassays or competition studies.

Inventions II and VII are separate and distinct as the polypeptides of Invention II cannot be used in the methods of Invention VII.

Inventions III and IV are separate and distinct as they comprise completely differing biochemical and immunological entities having differing properties and uses. Invention III is drawn to antibodies, whereas Invention IV is drawn to antagonists which may or may not be antibodies.

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Inventions III and V are separate and distinct as the antibodies of Invention III cannot be used in the methods of Invention V.

Inventions III and VI are separate and distinct as the antibodies of Invention III cannot be used in the methods of Invention VI.

Inventions III and VII are separate and distinct as the antibodies of Invention III cannot be used in the methods of Invention VII.

Inventions IV and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the antagonists can be used in other methods such as immunization.

Inventions IV and VI are separate and distinct as the antagonists of Invention IV cannot be used in the methods of Invention VI.

Inventions IV and VII are separate and distinct as the antagonists of Invention IV cannot be used in the methods of Invention VII.

Inventions V and VI are separate and distinct as they are drawn to differing methods having different steps and leading to differing results.

Inventions V and VII are separate and distinct as they are drawn to differing methods having different steps and leading to differing results.

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Inventions VI and VII are separate and distinct as they are drawn to differing methods having different steps and leading to differing results.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Zeman whose telephone number is (703) 308-7991. The examiner can be reached between the hours of 7:30 am and 4:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, Donna Wortman, Primary Examiner can be reached at (703) 308-1032.

The fax number for this Art Unit is (703) 305-7401.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1032 or the examiner's supervisor, Anthony Caputa, can be reached at (703)308-3995.

  
DONNA WORTMAN  
PRIMARY EXAMINER

Robert A. Zeman

February 24, 2000